

### **REMARKS**

Claims 1-3, 5-7, 20 and 22-37 are now pending in the application upon admission of new claims 33-37. Claims 1, 3, 5-6, 25 and 31 have been amended. Claims 4, 8-19 and 21 have been canceled. The basis for the foregoing amendments may be found throughout the written description, drawings and claims as originally filed. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein. Applicant respectfully requests an Interview with the Examiner if the currently pending claims are still not allowable.

### **EXAMINER INTERVIEW**

Applicant would like to thank the Examiner for the courtesy extended during an Examiner Interview on June 30, 2008. During the interview, Applicant's representative and the Examiner discussed the pending claims of record in view of the prior art. Applicant's representative discussed with the Examiner novel features provided in the instant application over the art of record. Specifically, Applicant's representative discussed the merits of the Examiner's position taken in the most recent Office Action with regard to the 35 U.S.C. §103 rejection of U.S. Patent Application No. 2002/0019649 (Sikora) in view of U.S. Pat. No. 5,702,462 (Oberlander). In the most recent Office Action, The Examiner has stated "Applicant's arguments are not persuasive because the rejection is modifying Sikora with teachings by Oberlander, not modifying Oberlander with teachings by Sikora" (page 2, Office Action dated March 31, 2008). Applicant submits that the Examiner's position is without merit.

Applicant submits that if reference A (Oberlander) specifically teaches away from the teachings of reference B (Sikora), the Examiner cannot cure this discrepancy by simply reversing the order and arguing that B does not teach away from A. Applicant argues that the references must be considered as a whole. See also *In re Fine* 837 F2d 1071 (Fed. Cir. 1988). Secondly, Applicant submits that Oberlander in at least the background specifically teaches away from creating an entrance puncture and an exit puncture because of the trauma experienced by the body tissue. The Examiner has taken the position that Oberlander still does not teach away from providing anchors that involve penetration of the meniscus on two sides. No specific agreement was reached as a result of the Examiner interview.

**REJECTION UNDER 35 U.S.C. §112**

Claims 6 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Applicant has corrected this informality and respectfully requests reconsideration and withdrawal of this rejection.

**INFORMATION DISCLOSURE STATEMENT**

Applicant requests clarification of the reason that certain documents were not considered in the most recent Office Action. Applicant submitted copies of the documents on December 28, 2007 and is enclosing herewith a copy of the acknowledgement postcard dated December 28, 2007. Should the Examiner require another copy of the twelve noted references, please advise.

**REJECTION UNDER 35 U.S.C. §103**

Claims 1-3, 7, 20, and 22-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0019649 (Sikora) in further view of U.S. Pat. No. 5,702,462 (Oberlander) and U.S. Pat. Pub. No. 2003/0130694 (Bojarski). This rejection is respectfully traversed.

Applicant traverses the rejection under 35 U.S.C. §103(a) on Sikora in view of Oberlander as discussed in detail in the "Examiner Interview" section above. Furthermore, as discussed during the Examiner Interview, Applicant maintains that Oberlander specifically teaches away from locating any anchors on an outer surface of the tissue. Oberlander identifies deficiencies in the prior art that require an entrance puncture and an exit puncture. Specifically, Oberlander states, "all of these techniques involve the penetration of the meniscus on two sides, thereby creating an entrance puncture and an exit puncture, the exit puncture typically being located at the outer rim of the meniscus" (see column 1, lines 65-67 through column 2, line 1). Oberlander then states that "it is desirable to have an alternative technique which causes less trauma to

the body tissue" (see column 2, lines 29-33). Those skilled in the art will readily appreciate that by creating an entrance puncture and an exit puncture the tissue can experience trauma. Oberlander intends to overcome such deficiencies by requiring both anchors to be embedded within the tissue, thereby reducing the trauma. Oberlander, therefore, teaches away from the configuration provided in Sikora that requires entrance and exit punctures.

Applicant submits that it is established that where references, instead of suggesting the invention, seek to warn to avoid the suggestion, such references diverge from and teach away from the invention at hand and it is error to find obviousness based on such references. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (citing W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Accordingly, for at least these reasons, reconsideration and withdrawal of this rejection as it pertains to claim 1 and dependent claims therefrom is respectfully requested.

Applicant further notes that claim 1 has been amended to include locating a blunt end of a hollow tube adjacent to the body tissue without penetrating the body tissue at a second insertion position distinct from the first insertion position, said hollow tube containing an anchor therein; and advancing a plunger within said hollow tube a predetermined distance toward said blunt end, thereby advancing said anchor, said anchor leading the advancement, to a position within the body tissue intermediate a portion of the tear and said second outer surface of the body tissue.

Applicant submits that the teachings of Sikora in view of Oberlander and Bojarski and even in further view of U.S. Pat. No. 5,954,747 (Clark) fails to render obvious claim 1 as amended above. Applicant notes that while Clark may provide a blunt end 64, as identified by the Examiner, the instrument of Clark relies on a sharp piercing end of a needle 52 to advance the anchor 44 within the tissue. The anchor 44 of Clark does not lead the advancement through the tissue. Instead, it simply follows the path formed by the sharp end of the needle 52.

Applicant further submits that each of the prior art references require a needle to pierce the tissue and define an insertion path for the anchor. In contrast, the instant disclosure, as set forth in claim 1, provides a hollow tube having a blunt end that locates adjacent to the body tissue without penetrating the body tissue and further provides a plunger that advances within the hollow tube toward the blunt end and advances the anchor while the anchor leads the advancement to a position within the body tissue intermediate a portion of the tear and said outer surface of the body tissue. Each of the prior art references require a piercing member, such as a hollow needle to first define the insertion path through the tissue and an anchor to simply be guided along the hollow piercing member. In other words, none of the anchors provided in the prior art lead the advancement into the body tissue as provided in amended claim 1 of the instant disclosure.

For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claim 1 and dependent claims therefrom.

With respect to claims 20 and 27, Applicant submits that the rejection under 35 U.S.C. §103 as being unpatentable over Sikora in view of Oberlander is improper at least for the reasons discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claims 20 and 27 and dependent claims therefrom.

Claims 4-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sikora in view of Oberlander and Bojarski and in even further view of U.S. Pat. No. 4,669,473 (Richards) and U.S. Pat. No. 5,954,747 (Clark). This rejection is respectfully traversed.

Applicant notes that claim 4 has been canceled and claims 5 and 6 have been amended to be dependent upon claim 1. In view of the amendments and discussion above with respect to claim 1, Applicant respectfully submits that claims 5 and 6, by at least the nature of their dependency, are likewise in condition for allowance.

Claims 30-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sikora in view of Oberlander and Bojarski and in even further view of U.S. Pat. No. 5,462,560 (Stevens) and U.S. Pat. No. 5,954,747 (Clark). This rejection is respectfully traversed.

At the outset, Applicant notes that claims 30-32 are ultimately dependent upon claim 27. For at least the reasons discussed above, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Applicant further notes that claim 30 requires "said hollow tube having a second length that is less than said first length, such that said piercing end extends beyond said

blunt end", and "said anchor piercing the meniscus during said advancing". The most recent Office Action is silent on these limitations. The Examiner appears to be using the fourth and fifth references (Stevens and Clark) in this rejection under §103 to illustrate a blunt end (feature 64 of Clark) and the different length needles (Fig. 1 of Stevens). Applicant submits that it is unclear how one skilled in the art can legitimately combine the teachings of all five of these references and arrive at claim 30 (or 31 or 32). Applicant further submits that even if one skilled in the art can reasonably incorporate the teachings of all five references into a single method of repairing a tear in a meniscus, the method of claim 30 would still not result. Applicant again notes that none of the collective art of record shows locating a blunt end of a hollow tube on the second insertion position, advancing a plunger within the hollow tube, thereby advancing the anchor to a desired location in the meniscus, the anchor piercing the meniscus during the advancement. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection as it pertains to claims 30-32.

#### **NEW CLAIMS 33-37**

New claims 33-37 have been added for substantive examination. Applicant submits that these claims are supported by the application as originally filed. No new matter has been entered. Applicant submits that claims 33-37 provide methods of repairing a tear in body tissue that are not taught or rendered obvious by the collective art of record.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance.

Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

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Respectfully submitted,

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